

Appl. No.: 09/826,708.

Amendment and Reply to Office action of September 9, 2004

### **Remarks/Arguments**

**In the Claims:** Possible claim amendments were discussed with Examiner Azizul Choudhury in the telephone interview of October 7, 2004, along with questions concerning the prima facie case of obviousness (see Errors in Rejection below). No agreement was reached regarding the claims. However, Claim 5 is amended in response to the Examiner's rejection, and in response to the telephone interview. The amendment adds elements ("communicating to said sender at least one of said recipients' preferences concerning e-mail received by said recipient, before said e-mail message is transmitted to said recipient ... wherein said sender can compose the content of said tags") based on Claims 4 and 7, FIGS. 1-6, and the written description. These elements are not described nor suggested in the references relied upon by the Office. The amendment should remove any doubt that at least Claim 5 has allowable subject matter.

### **Errors in Rejection**

The assignee respectfully asserts that:

It was erroneous to reject Claims 1-26, under 35 U.S.C. 103, over U.S. Pat. No. 5,377,354 (Scannell '354) and U.S. Pat. No. 6,779,178 B1 (Lloyd '178). A prima facie case of obviousness has not been established.

### **Argument regarding 35 U.S.C. 103 and lack of a prima facie case of obviousness:**

As stated in MPEP 2142: "The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness." As stated in MPEP 2143 and 2143.03, a

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requirement for establishing a prima facie case of obviousness is that the reference or references must teach or suggest all the claim limitations.

A. Limitations in the Rejected Claims Which Are Not Described in the References Relied On:

The following language from rejected Claims 1 and 5 provides an example:

tags "vary from one of said recipients to another." ("Tag" is defined in the specification of the subject patent application, at Page 3, or Paragraph 17 of the published version.)

The following language from rejected Claims 7 and 10 provides another example: "communicating to said sender at least one of said recipient's preferences concerning e-mail received by said recipient, before said e-mail message is transmitted to said recipient."

Neither Scannell '354 nor Lloyd '178 describe tags that may vary from one recipient to another. Neither Scannell '354 nor Lloyd '178 describe communicating anything to the sender about a recipient's preferences.

Concerning rejected Claims 1 and 5, the Examiner cites Col. 2, Lines 55-62 of Scannell '354. This section describes a system for a recipient to "automatically prioritize the plurality of" incoming email messages. The Examiner also cites Col. 3, Lines 1-5 of Scannell '354. This section describes "rules to screen each message," a priority code, and means for "selectively routing said screened message." The Examiner also cites Col. 4, Lines 50-68 of Scannell '354. This section describes forwarding a message to another user. The Examiner also cites Col. 2, Lines 10-29 of Lloyd '178. This section describes providing a sender with

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email customization “that incorporates personalized or customized images” into email messages. From this summary, one can see that neither Scannell ‘354 nor Lloyd ‘178 describe tags that may vary from one recipient to another.

Concerning rejected Claims 7 and 10, the Examiner cites Col. 7, Line 30-Col. 8, Line 33 of Scannell ‘354. This section describes details of prioritizing incoming email messages. The Examiner again cites Col. 2, Lines 55-62 of Scannell ‘354. This section introduces a system for a recipient to “automatically prioritize the plurality of” incoming email messages. The Examiner again cites Col. 4, Lines 50-68 of Scannell ‘354. This section describes forwarding a message to another user. The Examiner again cites Col. 2, Lines 10-29 of Lloyd ‘178. This section describes providing a sender with email customization “that incorporates personalized or customized images” into email messages. From this summary, one can see that neither Scannell ‘354 nor Lloyd ‘178 describe communicating to the sender at least one of the recipient's preferences concerning e-mail.

**B. Why the References, Taken as a Whole, Do Not Suggest the Claimed Subject Matter:**

The cited references do not suggest a solution involving above-mentioned subject matter of rejected Claims 1, 5, 7 and 10 for example. On the contrary, the cited references teach away from the claimed subject matter.

Teaching away is the antithesis of suggesting the claimed subject matter. Scannell ‘354 and Lloyd ‘178 teach away, by using examples of senders who transmit email without regard for recipients’ preferences, and email recipients who passively accept any kind of messages. Lloyd ‘178 teaches the passive

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acceptance of attached graphics files. Scannell '354 teaches that recipients passively accept any kind of messages, then process the messages later. (The "plurality of incoming mail messages is held in store in a main folder till accessed by the user for reading and action." Scannell at Col. 2, lines 52-54.) This teaching that recipients passively accept any kind of messages leads away from above-mentioned subject matter found in Applicant Dutta's Claims 7 and 10 for example: "communicating to said sender at least one of said recipient's preferences." The teaching that senders transmit, and recipients passively accept, any kind of messages leads away from claimed subject matter found in Dutta's Claims 9, 12, 19, and 26 for example: "tagging said e-mail message, to implement said [recipient's] preferences."

C. Why Features Disclosed in One Reference May Not Properly Be Combined with Features Disclosed in Another Reference:

As stated in MPEP 2143 and 2143.01, a requirement for establishing a prima facie case of obviousness is that there must be some suggestion or motivation to combine reference teachings. As stated in MPEP 2143.01: "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." Neither Scannell '354 nor Lloyd '178 suggest any combination of Scannell's screening of incoming email messages, with Lloyd's graphics in an email message. Thus a prima facie case of obviousness has not been established.

Furthermore, neither Scannell '354 nor Lloyd '178 suggest communicating to the sender the recipient's preferences concerning e-mail, in any combination (the

above-mentioned subject matter found in Applicant Dutta's Claims 7 and 10).

As stated in MPEP 2145 X. D. 2: "It is improper to combine references where the references teach away from their combination." Scannell '354 concentrates on the recipient's handling of plain text email, and thus teaches away from any combination involving the sender's emailed graphics of Lloyd '178. A search of the text of Scannell '354 confirms it does not contain the words "graphic" or "image." Thus it was improper to utilize these references as a basis for rejection of claims in the present case.

D. Differences Between the References, and the Claimed Invention as a Whole:

As quoted in MPEP 2141.02, a "patentable invention may lie in the discovery of the source of a problem .... This is part of the 'subject matter as a whole' which should always be considered in determining the obviousness of an invention under 35 U.S.C. 103." (Citing *In re Sponnoble*). In the present case, the specification (Pages 1 -2, or Paragraphs 2-3 of the published version) points out problems:

E-mail systems in use today make it easy for senders to send an e-mail message to a large number of recipients, and perhaps tag it as "urgent," although this may not be an accurate tag for many of the recipients.

E-mail systems in use today entail a second set of problems, regarding lengthy e-mail messages or e-mail messages with large files attached. Such messages may pose problems for a recipient who is not using a high-speed Internet connection, or a recipient who handles e-mail via hand-held devices .... Thus, some recipients may strongly prefer brief e-mail

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messages, without attachments. However, senders may not know of this preference.

Here are sources of problems. The references the Office action relies on (Scannell '354 and Lloyd '178) do not identify these problems. This should be considered as evidence of nonobviousness.

**Rejected Claims 2-4, 6, 8-9, and 11-26 are not separately argued.**

The points made above, concerning Claims 1, 5, 7 and 10, also apply to the remaining claims, which contain language similar to, or depend upon, Claims 1, 5, 7 and 10. A prima facie case of obviousness has not been established.

Concerning the dependent claims, the Examiner has not pointed out sections of the references that actually teach elements of the dependent claims. In rejecting the dependent claims, the Examiner again cites Col. 2, Lines 55-62 of Scannell '354 (mentioned above). This section introduces a system for a recipient to "automatically prioritize the plurality of" incoming email messages. The Examiner again cites Col. 3, Lines 1-5 of Scannell '354 (mentioned above). This section describes "rules to screen each message," a priority code, and means for "selectively routing said screened message." The Examiner again cites Col. 2, Lines 10-29 of Lloyd '178 (mentioned above). This section describes providing a sender with email customization "that incorporates personalized or customized images" into email messages.

The Examiner's references do not teach or suggest an element found in Dutta's Claims 3, 6, 15, 22 for example: "default tags may vary according to the status of

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said recipients.” The references do not teach or suggest an element found in Claims 4, 16, 23: “sender can compose the content of said tags.” The references do not teach or suggest an element found in Claims 9, 12, 19, and 26: tagging the e-mail message, “to implement said [recipient’s] preferences.”

In rejecting the dependent Claims 8, 11, 18, and 25, the Examiner cites above-mentioned sections, along with Col. 5, Line 1 of Scannell ‘354. This section describes providing the recipient with statistical information about the screening operations, such as the total number of messages and the number of messages forwarded. The Examiner’s references do not teach or suggest an element found in Dutta’s Claims 8, 11, 18, and 25: “preferences concern the size of e-mail messages sent to said recipient.”

Assignee respectfully submits that the rejection of Claims 1-26 should be withdrawn, and requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,



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